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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,412	10/10/2003	Eugenie Charriere	004900-254	3439

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BUCHANAN, INGERSOLL & ROONEY PC		
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EXAMINER	
SERGENT, RABON A	

ART UNIT	PAPER NUMBER
1711	

NOTIFICATION DATE	DELIVERY MODE
09/27/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No.

10/682,412

Applicant(s)

CHARRIERE ET AL.

Examiner

Rabon Sergeant

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/485,533.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 22, 2007 has been entered.

2. The amendments filed December 1, 2006 and August 22, 2007 are objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendments set forth within the paragraph at page 20, lines 2-6.

Applicants have argued that the amendments are supported by the original application, PCT/FR98/01800; however, this document is not in English and applicants have failed to provide a certified translation of the argued passage. Accordingly, it has not been adequately established that the amended subject matter precisely corresponds to the argued language of the PCT application.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. Claims 44-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It appears that applicants have relied upon the aforementioned PCT application to provide support for the amendments to claims 44 and 45; however, as aforementioned within paragraph 2, applicants have failed to provide a certified translation of the argued passage within the PCT application. Accordingly, applicants have failed to adequately establish that the amendment is properly supported.

4. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been provided for the amendments pertaining to “a biuretization catalyst”. Specifically, applicants have not established that the disclosed (cyclo)trimerization or (cyclo)condensation catalysts correspond to or encompass the claimed biuretization catalysts. Applicants’ response has been considered; however, it is not seen that it has adequately addressed the issue. Furthermore, the examiner has considered applicants’ argument in light of Example 12; however, the subject matter of the French patent is ineffective to clarify the situation, since the foreign patent has not been incorporated by reference and since essential material may be not been incorporated by reference to a foreign patent document. See MPEP 608.01(p). It is noted that applicants failed to address the rejection of this claim by amendment, in response to the final Office action of February 22, 2007.

5. Claim 50 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. .

Applicants have failed to provide support for the subject matter of claim 50 in that the examiner has found no clear support for component (a), at least one isocyanate dimer containing an isocyanurate unit.

6. Claims 44-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite applicants' response, it remains unclear if the language "isocyanate functions" refers to isocyanate groups or isocyanate monomers.

7. Claims 39, 40, 42, 43, 50 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. With respect to claims 39, 40, 42, and 43, the omitted steps pertain to how the claimed biuret unit is obtained absent a step of producing the biuret trimer reaction product. With respect to claim 50, the omitted steps pertain to how to obtain the claimed isocyanurate unit from a starting reaction medium that only contains an isocyanate monomer. The claimed process steps fail to allow for the production of the claimed isocyanurate unit. With respect to claim 51, the omitted steps pertain to how to obtain the claimed isocyanurate units or biuret units. Applicants' claimed step of reacting the isocyanate monomers with a compound comprising at least one function other than isocyanate function fails to allow for or provide for the production of the claimed isocyanurate or biuret groups.

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8. Claims 50 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have failed to provide adequate written description for the production of isocyanurate groups or biuret groups by simply reacting an isocyanate monomer with a compound comprising a function other than an isocyanate function.

9. Claims 50 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the "at least function other than an isocyanate function" is required to an isocyanate reactive function.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

  
RABON SERGENT  
PRIMARY EXAMINER

R. Sergent  
September 19, 2007